

REMARKS

Applicants filed an Amendment and Response to Office Action on December 3, 2004. A Notice of Non-Compliant Amendment dated April 12, 2005 was received. Apparently the only “non-compliance” attributed to the Amendment filed by Applicants was that the claim status identifier read “Presently Amended” rather than “Currently Amended.” While it is not clear how one would not be able to identify the individual status of each claim given the use of the word “presently” versus “currently,” Applicants have nonetheless changed the claim status identifiers to use the term “currently.” All other administrative features of the amendment appear proper (e.g., use of strike through and underlining, etc.).

Accordingly, below, Applicants resubmit the entire Amendment and Response to Office Action from December 3, 2004.

In addition to the amendments filed on December 3, 2004 (and repeated herein), Applicants also submit an additional amendment to the claims. That is, as is evident above, Applicants have added new independent claim 36 for consideration.

The present application was filed on May 31, 2001 with claims 1-35. In the outstanding Office Action, the Examiner: (i) objected to the drawings; (ii) objected to the present specification; (iii) objected to the Abstract; (iv) objected to claims 1, 2, 17 and 18; (v) rejected claims 1-35 under 35 U.S.C. §112 second paragraph as being indefinite; (vi) rejected claims 1, 2, 5-8, 17, 18, 21-24 and 33-35 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,256,773 to Bowman-Amuah (hereinafter “Bowman”); and (vii) rejected claims 3, 4, 9-16, 19, 20 and 25-32 under 35 U.S.C. §103(a) as being unpatentable over Bowman in view of U.S. Patent No. 6,226,792 to Goiffon et al. (hereinafter “Goiffon”).

Regarding the drawing objection with respect to reference numeral “45” in FIG. 7, Applicants have amended FIG. 7 to denote the block labeled “Project Definitions as “40” rather than “45.” This change is consistent with page 41, line 4, of the present specification. The proposed change to FIG. 7 is marked in red on the replacement sheet attached hereto. It is respectfully requested that the proposed change be entered and the objection be withdrawn.

Regarding the drawing objection with respect to reference numerals “22” and “86” both being used to designate “XSCML Processor” and reference numerals “41” and “82” both being used

to designate "Project Meta Data," Applicants respectfully point the Examiner to page 43, line 22, through page 44, line 1, of the present specification where the use of such reference numerals is clearly explained. Thus, it is respectfully requested that the objection be withdrawn.

Regarding the drawing objection with respect to reference numerals 53, 56, 57, 58 and 60, Applicants have amended the present specification to add reference to "53" and "60" at the appropriate locations. With respect to "56," "57" and "58," Applicants respectfully point the Examiner to page 12, line 21 and 22, of the present specification, where the reference numerals are clearly noted. Thus, it is respectfully requested that the objection be withdrawn.

Regarding the drawing objection with respect to reference numeral 26, Applicants have amended the present specification at page 44, line 15, to change the reference to "second server 26" to "second server 27 (Figure 2)." Thus, it is respectfully requested that the objection be withdrawn.

Regarding the objection to the Abstract, Applicants have amended same to comply the request to restrict the length to 150 words. Thus, it is respectfully requested that the objection be withdrawn.

Regarding the objection to the present specification, Applicants do not agree that same is "replete with spelling errors." Applicants have reviewed the present specification in an attempt to pick up any spurious spelling errors, and have amended them accordingly. With respect to the term "reproducible," Applicants respectfully point out that this is a correct spelling of the term. Thus, it is respectfully requested that the objection be withdrawn.

Regarding the further objection to the present specification, Applicants do not agree that same is "replete with terms which are not clear, concise and exact." Again, Applicants have reviewed the present specification in an attempt to pick up any spurious unclear language, and have amended it accordingly. With respect to reference numeral "139" on page 46, line 24, Applicants have corrected this to be "131," which is clear from FIG. 13. With respect to the language at page 46, line 19, Applicants have amended same for purposes of further clarity. Thus, it is respectfully requested that the objection be withdrawn.

Applicants appreciate the Examiner's review of the present specification. If the Examiner becomes aware of any other portions of the present specification that may have spelling errors or

typographical errors, Applicants would appreciate the Examiner bringing them to Applicants' attention, at which time Applicants will address them accordingly.

Regarding the objection to claims 1, 2, 17 and 18, Applicants have amended such claims to correct the term "or." Thus, it is respectfully requested that the objection be withdrawn.

Regarding the §112, second paragraph, rejection with respect to claim 1, while Applicants respectfully traverse such rejection, Applicants have nonetheless amended such claim as follows. The term "operable," while permissible in claim language, is replaced with the term "useable." Thus, it is clear that the claim expressly recites how the "common software configuration markup language" is utilized. There is no vagueness in the use of terms such as "operable," "useable," etc., since they clearly mean that the subject element is capable of being operating or being used in the recited manner. Applicants have also removed the associated "at least one of" phrase in claim 1. Thus, it is respectfully requested that the §112, second paragraph, rejection be withdrawn.

With respect to claim 14, the use of the phrase "at least one of step (a) and step (b)" does not preclude a dependent claim from limiting step (a) and then a further dependent claim from limiting step (b). The use of the phrase "at least one of step (a) and step (b)" is known to refer to the fact that the scope of the method can comprise step (a) alone, step (b) alone, or both step (a) and (b). When a dependent claim further limits one step or the other step, Applicants do not see how there can be any vagueness in determining, for purposes of claim scope, which step is being performed. Thus, it is respectfully requested that the §112, second paragraph, rejection be withdrawn.

With respect to claim 33, Applicants have amended such claim to provide proper antecedent basis for the phrase "one or more library systems." Thus, it is respectfully requested that the §112, second paragraph, rejection be withdrawn.

Regarding the §102(e) rejection of claims 1, 2, 5-8, 17, 18, 21-24 and 33-35, the Office Action contends that Bowman discloses all of the claim limitations recited in the subject claims. Applicants respectfully assert that Bowman fails to teach or suggest all of the limitations in claims 1, 2, 5-8, 17, 18, 21-24 and 33-35, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed.

Cir. 1987). Applicants assert that the rejection based on Bowman does not meet this basic legal requirement, as will be explained below.

By way of example, amended independent claim 1 recites a method of configuring software, the method comprising utilizing a common software configuration markup language in a computer system including at least one server which is connected to a plurality of client computers, the server having a memory for storing product elements which may be linked together to form at least one version of a software package, and further for storing processes usable by the clients to at least one of maintain the product elements and develop new product elements, and tools usable by the clients to at least one of define, maintain and update relations between product elements. The common software configuration markup language is useable to define a project, perform a memory access to at least one of product elements and packages, map one or more of the processes and tools to one or more library systems, and define relations between the product elements, and further wherein a framework associated with the common software configuration markup language is system-independent. Independent claims 17, 33 and 34 recite at least some similar limitations.

As noted above, Applicants have removed the "at least one of" language in independent claims 1, 17 and 34 to further clarify the uses of the common software configuration markup language of the claimed invention.

The Office Action cites column 8, lines 7-30, of Bowman in support of rejecting the "common software configuration markup language," of the claimed invention. In particular, the Office Action cites the following text from Bowman:

Thus, through the development of frameworks for solutions to various problems and programming tasks, significant reductions in the design and development effort for software can be achieved. A preferred embodiment of the invention utilizes HyperText Markup Language (HTML) to implement documents on the Internet together with a general-purpose secure communication protocol for a transport medium between the client and the Newco. HTTP or other protocols could be readily substituted for HTML without undue experimentation. Information on these products is available in T. Berners-Lee, D. Connolly, "RFC 1866: Hypertext Markup Language--2.0" (November 1995); and R. Fielding, H. Frystyk, T. Berners-Lee, J. Gettys and J. C. Mogul, "Hypertext Transfer Protocol--HTTP/1.1: HTTP Working Group Internet Draft" (May 2, 1996). HTML is a simple data format used to create hypertext documents that are portable from one platform to another. HTML documents are SGML documents with generic semantics that are appropriate for

representing information from a wide range of domains. HTML has been in use by the World-Wide Web global information initiative since 1990. HTML is an application of ISO Standard 8879; 1986 Information Processing Text and Office Systems; Standard Generalized Markup Language (SGML). (Underlining added for emphasis).

In particular, the Office Action suggests that the mention of HTML in Bowman is sufficient to reject the "common software configuration markup language," of the claimed invention. However, Applicants point out that Bowman merely states that "[a] preferred embodiment of [Bowman] utilizes HyperText Markup Language (HTML) to implement documents on the Internet . . . ." No where does Bowman disclose "a common software configuration markup language" that is "useable to define a project, perform a memory access to at least one of product elements and packages, map one or more of the processes and tools to one or more library systems, and define relations between the product elements, and further wherein a framework associated with the common software configuration markup language is system-independent," as in the claimed invention.

Furthermore, Bowman even discredits the use of a markup language such as HTML by immediately going on to state, at column 8, lines 31-43, the problems with HTML:

To date, Web development tools have been limited in their ability to create dynamic Web applications which span from client to server and interoperate with existing computing resources. Until recently, HTML has been the dominant technology used in development of Web-based solutions. However, HTME [sic] has proven to be inadequate in the following areas: [p]oor performance; [r]estricted user interface capabilities; [c]an only produce static Web pages; [l]ack of interoperability with existing applications and data; and [i]nability to scale.

Thus, Applicants assert that Bowman does not meet the basic legal requirement of the above-cited Federal Circuit decision in *Verdegaal Bros. v. Union Oil Co. of California*. Thus, it is respectfully requested that the §102(e) rejection of claims 1, 2, 5-8, 17, 18, 21-24 and 33-35 be withdrawn.

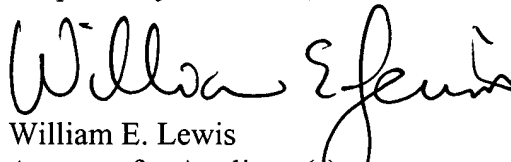
Regarding the §103(a) rejection of claims 3, 4, 9-16, 19, 20 and 25-32, Applicants assert that said claims are patentable over the Bowman/Goiffon combination since Goiffon fails to remedy the above-mentioned deficiencies of Bowman.

Further, in addition to the reasons for patentability presented above, Applicants assert that dependent claims 2-16, 18-32 and 35 also respectively recite patentable subject matter in their own right.

Still further, for at least the reasons given above, Applicants assert that new independent claim 36 is also allowable.

In view of the above, Applicants believe that claims 1-36 are in condition for allowance, and respectfully request withdrawal of the various §112, §102(e) and §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis", is written over the typed name and address.

William E. Lewis  
Attorney for Applicant(s)  
Reg. No. 39,274  
Ryan, Mason & Lewis, LLP  
90 Forest Avenue  
Locust Valley, NY 11560  
(516) 759-2946

Date: April 15, 2005